

REMARKS

This Amendment is submitted in response to the Office Action dated January 11, 2005. In the Office Action, the Patent Office rejected Claims 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* (U.S. Patent No. Des. 286,650) in view of *Martin et al.* (U.S. Patent No. 1,134,691). Further in the Office Action, the Patent Office rejected Claim 17 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin et al.* and further in view of *Jones* (U.S. Patent No. 5,882,667).

Applicant notes with appreciation that the Patent Office indicated that Claim 19 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Further, Applicant notes with appreciation that the Patent Office stated that Claims 9, 11, 14, and 21 are in allowable form.

By the present Amendment, Applicant amended Claims 15 and 17. Further, Applicant canceled Claim 19 and added Claim 22. Applicant submits that the amendment to the claims overcomes the rejection made by the Patent Office and that the cancellation of Claim 19 and addition of Claim 22 places the application in condition for allowance. Notice to that effect is requested.

With respect to the rejection of Claims 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin et al.*, Applicant submits that the amendment to Claim 15 overcomes the rejection and places the application in condition for allowance. Notice to that effect is requested.

In the Office Action, the Patent Office asserts:

"*Fischer* discloses a marking device having a barrel and sheath wrapped around the barrel wherein the sheath overlaps onto itself. Although the *Fischer* reference does not disclose an end cap and a connecting chain for securing the marking device, attention is directed to the *Martin* reference, which discloses another marking instrument 16 wherein an end cap 15 and a connecting chain 14 are used to secure the device when not in use."

Independent Claim 15, as amended, defines a marking device accessory kit having a marking device having a barrel defined by an exterior surface and a second end. Further, independent Claim 15, as amended, requires a sheath having an area defined within exterior edges and further defined by an inside surface and an outside surface. The inside surface of the sheath is continuously coated with an adhesive to cover the area within the exterior edges. When the sheath wraps around the exterior surface of the barrel of the marking device, the inside surface of the sheath overlaps onto the outside surface of the sheath. Further, independent Claim 15, as amended, requires that the inside surface of the sheath attach to the exterior surface of the barrel of the marking device and the outside surface of the sheath via the adhesive.

Fischer, as illustrated in Figs. 1-6, merely teaches a marking device and a sheath defined by an inside surface and an outside surface wherein one end of the inside surface of the sheath abuts and joins to an opposite end of the inside surface of the sheath. *Martin et al.* merely teach a pencil-holding device that suspends the pencil above the writing surface.

Neither *Fischer* nor *Martin et al.*, taken either singly or in combination, teaches or suggests a marking device accessory kit having a sheath having an area defined within exterior edges and further defined by an inside surface and an outside surface, wherein the inside surface of the sheath is continuously coated with an adhesive to cover the area within the exterior edges, as required by independent Claim 15, as amended. Further, neither *Fischer* nor *Martin et al.*, taken either singly or in combination, teaches or suggests the sheath wrapping around an exterior surface of a barrel of a marking device, wherein the inside surface of the sheath overlaps onto the outside surface of the sheath, as required by independent Claim 15, as amended. Still further, neither *Fischer* nor *Martin et al.*, taken either singly or in combination, teaches or suggests the inside surface of the sheath attaching to the exterior surface of the barrel of the marking device and to the outside surface of the sheath via the adhesive, as required by independent Claim 15, as amended.

With respect to the rejection of Claim 17 under 35 U.S.C. §103(a) as being unpatentable over *Fischer* in view of *Martin et al.* and further in view of *Jones*, Applicant submits that the amendment to Claim 17 overcomes the rejection and places the application in condition for allowance. Notice to that effect is requested.

In the Office Action, the Patent Office asserts:

"As discussed supra, *Fischer* and *Martin* disclose the claimed marking instrument, sheath, end cap and connecting lead. Further, the method as claimed is inherent in the usage of the device discussed above. Although the sheath in the *Fischer* reference is not disclosed as being coated with an antimicrobial substance, attention is directed

to the *Jones* reference, which discloses another sheath of the marking instrument wherein the sheath is coated with such a substance in order to render the device sanitary."

Independent Claim 17, as amended, defines a method of using a marking device having the step of providing a barrel defined by an exterior surface and further defined between a first end and a second end. Further, independent Claim 17, as amended, requires the steps of providing a sheath that overlaps onto itself when wrapped around the exterior surface of the barrel and providing a band secured around the sheath to hold the sheath on the barrel. Still further, independent Claim 17, as amended, requires the steps of providing an end cap wherein the end cap has a connecting lead that extends from the end cap, fitting the sheath over the barrel and fitting the end cap over the second end of the barrel.

Fischer, as illustrated in Figs. 1-6, merely teaches a marking device and a sheath defined by an inside surface and an outside surface wherein one end of the inside surface of the sheath abuts and joins to an opposite end of the inside surface of the sheath. *Martin et al.* merely teach a pencil-holding device that suspends the pencil above the writing surface.

Jones merely teaches or suggests a plastic sleeve covering containing an antimicrobial agent to resist or prevent then growth of microbes on the surface thereof, thereby preventing cross-contamination of subsequent users following the use of the item by an infected individual. Moreover, *Jones* merely teaches or suggests that the sterile plastic sleeve may have a groove that allows the plastic sleeve to enlarge and accept a non-sterile writing pen.

None of *Fischer*, *Martin et al.*, or *Jones*, taken singly or in

combination, teaches or suggests a method of using a marking device having the step of providing a sheath that overlaps onto itself when wrapped around the exterior surface of the barrel and providing a band secured around the sheath to hold the sheath on the barrel, as required by independent Claim 17, as amended. Further, none of *Fischer*, *Martin et al.*, or *Jones*, taken singly or in combination, teaches or suggests the steps of providing an end cap wherein the end cap has a connecting lead that extends from the end cap, fitting the sheath over the barrel and fitting the end cap over the second end of the barrel, as required by independent Claim 17, as amended.

Moreover, one of ordinary skill in the art at the time of Applicant's invention would never have been motivated to combine *Fischer* with *Martin et al.* or *Fischer* and *Martin et al.* in view of *Jones* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's marking device accessory kit and method for using a marking device. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988). Moreover, Applicant submits that absolutely no teaching, suggestion and/or incentive exists to combine *Fischer* with *Martin et al.* or *Fischer* and *Martin et al.* with *Jones* in the manner suggested by the Patent Office. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the resultant combination still lacks the novel structural elements and steps positively recited in Claims 15 and 17, respectively. Namely, neither *Fischer*, nor *Martin et al.*, taken singly or in combination, teach or suggest a sheath defined by an inside surface and an outside surface wherein the inside surface is continuously coated in adhesive and wraps around the exterior surface of the barrel of the marking device and further wherein the inside surface of the sheath overlaps onto the outside surface of the sheath and attaches to the exterior surface of the marking device and the outside surface of the sheath via the adhesive, as required by independent Claim 15. Further, none of *Fischer*, *Martin et al.* or *Jones*, taken singly or in combination, teaches or suggests the step of providing a band secured around the sheath to hold the sheath on the barrel, as required by independent Claim 17. Accordingly, the rejection of Claims 15-17 by the Patent Office under 35 U.S.C.

§103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the objection to Claim 19 as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, Applicant states that this objection has been overcome by the cancellation of Claim 19 and addition of Claim 22. The new independent Claim 22 contains the limitations previously defined in Claim 19 and the limitations previously defined in independent Claim 17. Accordingly, the objection to Claim 19 by the Patent Office has been overcome and should be withdrawn. Notice to that effect is requested.

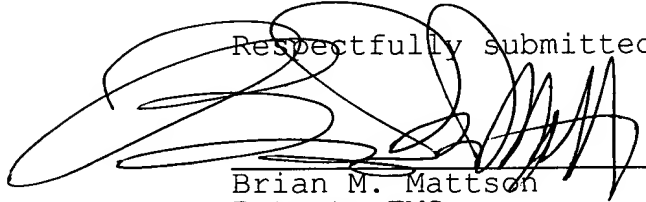
Claim 16 depends from independent Claim 15. This claim is further believed allowable over the references of record for the same reasons set forth with respect to Claim 15 since Claim 16 sets forth additional structural elements of Applicant's marking device accessory kit.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Notice to that effect is requested.

If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue.

Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

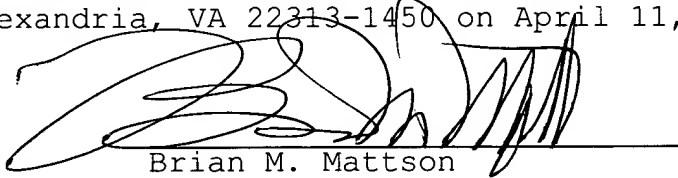


(Reg. No. 35,018)

Brian M. Mattson
Patents+TMS
A Professional Corporation
1914 North Milwaukee Avenue
Chicago, IL 60647
773/772-6009
Attorney for Applicant

CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 11, 2005.



Brian M. Mattson